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10/067,875	02/05/2002	Timothy R. Kane	END920020006US1	6282
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EXAMINER LIN, KENNY S				
ART UNIT 2478		PAPER NUMBER		
NOTIFICATION DATE 12/13/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary

Application No.

10/067,875

Applicant(s)

KANE ET AL.

Examiner

Kenny S. Lin

Art Unit

2478

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. Claims 1-21 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/13/2010 has been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 16-21 are rejected under 35 U.S.C. 101 because the invention is not limited to tangible embodiments. As such, the claim is not limited to statutory subject matter and is therefore non-statutory. See MPEP § 2106. A program product stored on a recordable medium such as carrier wave or optical wave is not tangible since such computer transport medium does not fall into the categories of "process", "machine", "manufacture" and "composition of matter". (wave and signals are all recordable by recording devices). The language of claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application

producing a useful, concrete and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. The claim appear to define the metes and bounds of an invention comprised of software alone without claiming associated computer hardware required for execution. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts. Correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the specification discloses the limitation of "routing the transformed alternate data to **the destination** using the retrieved different communication protocol". The specification at most disclose to route each data to it's corresponding destination. For example, figure 3 shows that each data has a corresponding source, destination, trans type, format and protocol. Therefore, how is an alternate data (a different data from "the data" as claimed) be routed to "the destination" that is corresponding to "the data"? Do you mean "the alternate destination"?

7. Claims 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the specification discloses the limitation of “detecting errors in the alternate data based upon omissions in **the data**”. What does the omission in “the data” has to do with the alternate data which is completely different from “the data”? Do you mean “omission in alternate data”?

8. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not enable one skilled in the art to make or use the limitation of “routing the transformed alternate data to **the destination** using the retrieved different communication protocol” and “detecting errors in the alternate data based upon omissions in **the data**”. These claim limitations were not described in the specification.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 3, 10, 12, 16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Endo, US 2004/0212841, filed on April 30, 2004 with a priority date to a divisional application filed on October 26, 1998.

11. Endo was cited in the previous office action.

12. As per claim 1, Endo taught the claimed invention including a method for routing data by a server, comprising the step of:

- a. Providing an application on the server (pp. 0048-0049, system or program is loaded from the HD drive, OS program, document-transmission control program);
- b. Providing a table of formats and protocols on the server, wherein the table is accessible by the application, wherein the table contains a plurality of formats and protocols (pp. 0049, 0052-0053, 0055-0056, 100-105, default data-transmission-format information base and various transmission protocols, destination list);
- c. Receiving, on the server, data to be routed from a source to a destination (pp. 0048-0049; server HD reading, loading and storing document read from a scanner for transmission), the data having the destination (e.g. receiver email address, ftp address; figs.4-8) and a transaction type that defines a purpose for which the data

included therein is used (e.g. transmission methods such as email defines how the data will be transmitted; figs. 4-8, pp. 0058: transmission method 502), (pp. 0055-0056, 0060-0065, figs.3-4, 8-9; document input unit; data are collected in accordance with data transmission format based classification and communication-method based classification);

- d. Retrieving, from the table, a format, distinct from the transaction type (pp. 0055, data transmission format. Figs. 4-8: format 1, format 2 or format 3), for transforming the data and a protocol of the plurality of protocols for communicating the data based on the destination, the transaction type and the source (pp. 0055-0056, 0058-0059, 0061, 100-105);
- e. The application transforming the data into the retrieved format, and routing the transformed data to the destination using the retrieved communication protocol (pp. 0055-0056, 0065-0066, 0068-0069, 0096-0097),
- f. receiving, on the server, alternate data to be routed from an alternate source (pp. 0048-0049: data inputted from floppy drive 204) to an alternate destination (e.g. receiver email address, ftp address; figs 4-8 alternate rows), the alternate data having the alternate destination and an alternate transaction type that defines a purpose for which the alternate data included therein is used (e.g. alternate transmission methods such as ftp, fax, lpr and database defines how the data will be transmitted; figs. 4-8, pp. 0058: transmission method 502);
- g. retrieving, from the table, a different format of the plurality of formats for transforming the alternate data and a different protocol of the plurality of

protocols for communicating the alternate data based on the alternate destination, the alternate transaction type and the alternate source (pp. 0055-0056, 0058-0059, 0061, 100-105, figs. 4-8 format 1, format 2, or format 3); and

- h. the application transforming the alternate data into the retrieved different format, and routing the transformed alternate data to the destination using the retrieved different communication protocol (pp. 0055-0056, 0065-0066, 0068-0069, 0096-0097).
13. As per claims 10 and 16, Endo taught the claimed invention including a system and its program product for routing data by a server, comprising:
- a. A table system for providing a table having a plurality of formats and protocols (pp. 0048-0049, 0052-0053, 0055-0056, default data-transmission-format information base and various transmission protocols, destination list);
 - b. A data reception system for receiving data from a source to be routed to a destination (pp. 0048-0049), the data having a destination and a transaction type that defines a purpose for which the data included therein is used (pp. 0055-0056, 0060-0065, figs.3-4, 8-9; document input unit; data are collected in accordance with data transmission format based classification and communication-method based classification) and for receiving alternate data from an alternate source to be routed to an alternate destination, the data having the alternate destination and an alternate transaction type that defines a purpose for which the alternate data include therein is used (pp. 0048-0049: data inputted from floppy drive 204 to

transmitted to receiver destinations such as email address, ftp address; figs 4-8
alternate rows with alternate transmission methods such as ftp, fax, lpr and
database defines how the data will be transmitted; figs. 4-8, pp. 0058:
transmission method 502);

- c. A retrieval system for retrieving a format, distinct from the transaction type (pp. 0055, data transmission format. Figs. 4-8: format 1, format 2 or format 3), of the plurality of formats for transforming the data and a protocol of the plurality of protocols for communicating the data from the table based upon the source, the destination and the transaction type (pp. 0055-0056, 0058-0059, 0061, 100-105) and for retrieving a different format of the plurality of formats for transforming the alternate data and a different protocol of the plurality of protocols for communicating the alternate data from the table based upon the alternate source, the alternate destination and the alternate transaction type (pp. 0055-0056, 0058-0059, 0061, 100-105, figs. 4-8 format 1, format 2, or format 3);
- d. A transformation system for transforming the data into the retrieved format and for transforming the alternate data into the retrieved different format (pp. 0055-0056, 0065-0066); and
- e. A routing system for routing the transformed data to the destination using the retrieved protocol and for routing the transformed alternate data to the alternate destination using the retrieved different protocol (pp. 0055-0056, 0065-0066, 0068-0069, 0096-0097).

14. As per claims 3, 12 and 18, Endo taught the invention as claimed in claims 1, 10 and 16. Endo further taught to comprise the step of identifying the source, prior to the retrieving step (pp. 0065; designate the document input source).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 4, 7, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo, US 2004/0212841, in view of Olejar et al (Olejar), US 2003/0037100.

17. Olejar was cited in the previous office action.

18. As per claim 7, Endo taught the invention substantially as claimed including a method for routing data by a server, comprising the steps of:

- a. Providing a communication application on the server (pp. 0048-0049, system or program is loaded from the HD drive, document-transmission control program);
- b. Entering a table of formats, protocols, sources, destinations and transaction types on the server, wherein the table is accessible by the application, wherein the table contains a plurality of formats and protocols (pp. 0049, 0052-0053, 0055-0056,

- default data-transmission-format information base and various transmission protocols, destination list);
- c. Receiving, on the server, data to be routed from an identified source to a destination (pp. 0048-0049), the data having the destination and a transaction type that defines a character of the data included therein (pp. 0055-0056, 0060-0065, figs.3-4, 8-9; document input unit; data are collected in accordance with data transmission format based classification and communication-method based classification);
 - d. Retrieving from the table a format of the plurality of formats for transforming the data and a protocol of the plurality of protocols for communicating the data, based on the destination, the transaction type and the source (pp. 0055-0056, 0058-0059, 0061, 100-105);
 - e. The application transforming the data into the retrieved format, and routing the transformed data from the server to the destination using the retrieved communication protocol (pp. 0055-0056, 0065-0066, 0068-0069, 0096-0097),
 - f. receiving, on the server, alternate data to be routed from an alternate source (pp. 0048-0049: data inputted from floppy drive 204) to an alternate destination (e.g. receiver email address, ftp address; figs 4-8 alternate rows), the alternate data having the alternate destination and an alternate transaction type that defines a purpose for which the alternate data included therein is used (e.g. alternate transmission methods such as ftp, fax, lpr and database defines how the data will be transmitted; figs. 4-8, pp. 0058: transmission method 502);

- g. retrieving, from the table, a different format of the plurality of formats for transforming the alternate data and a different protocol of the plurality of protocols for communicating the alternate data based on the alternate destination, the alternate transaction type and the alternate source (pp. 0055-0056, 0058-0059, 0061, 100-105, figs. 4-8 format 1, format 2, or format 3); and
 - h. the application transforming the alternate data into the retrieved different format, and routing the transformed alternate data to the destination using the retrieved different communication protocol (pp. 0055-0056, 0065-0066, 0068-0069, 0096-0097).
19. Endo did not specifically teach to detect errors in the data or alternate data based upon omissions in the data. Olejar taught to detect errors in retrieved data based upon omissions in the data (claim 4; intelligent detection means). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Endo and Olejar because Olejar's teaching of detecting errors enable Endo's method to detect incomplete or inaccurate data received and automatically retrieve data to correct the problem (see Olejar, claim 4).
20. As per claims 4, 13 and 19, Endo taught the invention substantially as claimed in claims 1, 10 and 16. Endo did not specifically teach the step of the application detecting errors in the retrieved data based upon omissions in the data. Olejar taught an application to detect errors in retrieved data based upon omissions in the data (claim 4; intelligent detection means). It would

have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Endo and Olejar because Olejar's teaching of detecting errors enable Endo's method to detect incomplete or inaccurate data received and automatically retrieve data to correct the problem (see Olejar, claim 4).

21. Claim 2, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo, US 2004/0212841, in view of Deng, US 6,243,394.

22. Deng was cited in the previous office action.

23. As per claims 2, 11 and 17, Endo taught the invention substantially as claimed in claims 1, 10 and 16. Endo further taught that the provided table further includes sources, destinations and transaction type (figs.5-7; pp. 0055). Endo further taught to designate a document input source (pp. 0065). Endo did not specifically teach to include sources in the table. Deng taught to include sources in the table (col.5, lines 34-38, col.8, lines 44-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Endo and Deng and include sources to the table to inform the data receiver where the data is from.

24. Claim 5, 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo, US 2004/0212841, in view of Lakshman et al (Lakshman), US 6,078,564.

25. Lakshman was cited in the previous office action.

26. As per claims 5, 14 and 20, Endo taught the invention substantially as claimed in claims 1, 10 and 16. Endo did not specifically teach the step of tracking data communication between the source and the destination. Lakshman taught to track data communication between the source and the destination (col.4, lines 64-67, col.5, lines 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Endo and Lakshman because Lakshman's teaching of tracking communication enables Endo's method to monitor the transmission of the data transmitted in the communication path.

27. Claim 6, 15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo, US 2004/0212841, in view of Harris, Jr. et al (Harris), US 6,144,975.

28. Harris was cited in the previous office action.

29. As per claims 6, 15 and 21, Endo taught the invention substantially as claimed in claims 1, 10 and 16. Endo did not specifically teach further the step of generating a report based upon data communications and detected errors. Harris taught to generate a report based upon data communication and detected errors destination (col.1, lines 35-36, col.8, lines 54-67, col.9, lines 1-11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Endo and Harris because Harris' teaching of reporting enable Endo's method to present the users or the administer a documentary of the errors.

30. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Endo and Olejar as applied to claim 7 above, and further in view of Lakshman et al (Lakshman), US 6,078,564.

31. Lakshman was cited in the previous office action.

32. As per claim 8, Endo and Olejar taught the invention substantially as claimed in claim 7. Endo and Olejar did not specifically teach the step of tracking data communication between the source and the destination. Lakshman taught to track data communication between the source and the destination (col.4, lines 64-67, col.5, lines 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Endo, Olejar and Lakshman because Lakshman's teaching of tracking communication enables Endo and Olejar's method to monitor the transmission of the data transmitted in the communication path.

33. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Endo, Olejar and Lakshman as applied to claim 8 above, and further in view of in view of Harris, Jr. et al (Harris), US 6,144,975.

34. Harris was cited in the previous office action.

35. As per claim 9, Endo, Olejar and Lakshman taught the invention substantially as claimed in claim 8. Endo, Olejar and Lakshman did not specifically teach further the step of generating a report based upon data communications and detected errors. Harris taught to generate a report based upon data communication and detected errors destination (col.1, lines 35-36, col.8, lines 54-67, col.9, lines 1-11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Endo, Olejar, Lakshman and Harris because Harris, Olejar and Lakshman's teaching of reporting enable Endo's method to present the users or the administer a documentary of the errors.

Response to Arguments

36. Applicant's arguments filed 9/13/2010 have been fully considered but they are not persuasive.

37. In the remark, applicant argued that the transmission method of Endo indicates the manner in which the document data is to be transmitted and does not define the purpose use of the data itself. The transaction type is distinct from the format of the transaction. The transaction type is not taught by the transmission methods of Endo, which are merely formats.

Examiner disagrees. Endo specifically teaches a data having a transaction type that defines a purpose of the data included therein (pp. 0055-0056, 0060-0065, figs.3-4, 8-9; transmission method such as e-mail, facsimile, lpr, ftp, database) and formats (pp. 0053: data transmission formats). The transmission method such as e-mail, fax or ftp transmission methods clearly

provides a purpose for how the documents are transmitted. The transaction type taught by Endo is also distinct from the format of the data since Endo taught that the formats are, for example, JPEG, TIFF, BMP...etc, while the transaction type are, for example, e-mail, ftp, fox Ipr...etc. Assigning a transaction type such as e-mail, facsimile, Ipr essentially applies various encoding to the data such that the data being routed is encoded with the header and tailor that defines the data to be e-mail content data, facsimile content data or Ipr content data when transmitting the data. For example, transmitting a JPEG format data using email transmission method defines the JPEG format data to be an email content data used for email transmission (character of the JPEG data defined as an email content). Endo's teaching clearly read on the claim language of "transaction type" since the transmission methods indicates the data's delivering transactions. The specific transaction types such as "order or invoice" are not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

38. A shortened statutory period for reply to this Office action is set to expire **Three MONTHS** from the mailing date of this action.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Pwu can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kenny S Lin/
Primary Examiner, Art Unit 2478
December 8, 2010